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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,771	08/28/2006	Walter Wolf	016906-0489	2542

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EXAMINER

CAZAN, LIVIUS RADU

ART UNIT	PAPER NUMBER
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3729

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12/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,771	Applicant(s) WOLF, WALTER	
	Examiner LIVIOUS R. CAZAN	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 1-25 and 40-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/6/06, 6/30/06, 12/13/07, 4/8/09</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group III in the reply filed on 9/9/2010 is acknowledged. Applicant argues two main points: 1) group I is directed to a method that is specially adapted to manufacture the product of group III and the method of group I would inherently produce the product of group III; group IV includes the features of claim 1, which is included in the claims of group I; the Office used the term "special technical feature" in referring to the feature of plastic provided on the inner walls such that a cavity is formed between the plastic and the connection points and the base body, and, therefore, groups I, III, and IV share a common special technical feature. 2) the Office did not provide a reference to show the common feature of groups I, III, and IV is indeed known.

2. Regarding point 1), the Examiner respectfully disagrees. It is not true that the method of group I inherently results in the product of group III. As currently claimed, group I (refer to claim 1) is directed to a method for manufacturing a component comprising a base body, the component being *a hybrid component for a transverse beam of a vehicle or a front-end component in which the base body is formed from at least two elements which can be connected to one another at at least one connection point*. Group III is directed to a component for a transverse beam of a vehicle. However, if in claim 1 a component for a transverse beam of a vehicle is formed, it will not result in the same structure as in claim 26, because claim 1 does not state that the component for a transverse beam of a vehicle has a base body formed from at least two elements

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which can be connected to one another at at least one connection point. Even if claim 1 is read as *“a hybrid component, for a transverse beam of a vehicle or a front-end component, in which the base body is formed from at least two elements which can be connected to one another at at least one connection point”*, this method still does not inherently result in the structure of group III. Rather, the resulting structure depends on whether the component manufactured in claim 1 is for a transverse beam or if it is a front-end component. One cannot argue inherency when the same result is not always obtained.

3. Moreover, as is readily apparent from the art applied in the present Office Action, the feature common to groups I and III is not novel. Therefore, unity is lacking. This applies to group IV as well. Applicant argues that group I includes the features of claim 1, which is part of group I. However, group IV is directed to the use of products created using the method of claim 1. Group IV therefore has features which are not found in claim 1. Since the subject matter common to claims 1 and 40-44 is known, there remains no common special technical feature between groups I and IV.

4. Regarding point 2), the Examiner has reviewed the Requirement and Applicant's comments and agrees that the groups should have been deemed to lack unity *a posteriori*, rather than *a priori*, and a reference to support this assertion should have been provided. However, the present rejection shows that the common feature of groups I, III, and IV is known and, therefore, the fact still remains that unity is lacking between these groups, since they have no common special technical feature. Therefore, the Requirement is maintained and is made FINAL.

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5. **Claims 1-25 and 40-44** are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/9/2010.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 26-39** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. In particular, in claim 26, line 1, the phrase "a component, in particular a hybrid component, for a ... " appears to make it optional for the component to be a hybrid component. The claim should be amended to recite either --a component for a ... -- or -- a hybrid component for a ... --. The phrase "in particular" also appears in claims 30, 31, 34, and 37. These claims are indefinite, because they appear to list a preferred process or technique to use in the method, but do not limit the scope of the claims to what is listed.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 26-30, 32-34, 36, and 38** are rejected under 35 U.S.C. 102(b) as being anticipated by Mainka (US20010043835).

11. **Regarding claim 26**, Mainka discloses component (1), in particular a hybrid component, for a transverse beam of a vehicle, comprising a base body (5 with 6) which is at least partially lined with plastic (2) and which is formed from at least two elements (5, 6) which can be connected to one another at at least one connection point (at flanges 8, 9), the base body being provided on the inner walls with plastic in such a way that a cavity (space between 4 and 2) is formed in the region of one of the connection points between the connection point and the plastic.

12. **Regarding claim 27**, the size of the cavity is determined as a function of the type of the connection point and/or the thickness of the plastic. This is readily apparent. For example, if the plastic is thicker, the cavity becomes smaller.

13. **Regarding claim 28**, the cavity has a minimum distance between the connection point and the plastic of at least 0.8 mm and at most 25 mm. Note that the claim essentially states that a minimum distance has to be between 0.8 and 25mm. This actually equates to saying a distance is at least 0.8mm. The 25mm value does not actually limit anything, because one cannot put an upper bound on a minimum distance. One of ordinary skill in the art will instantly recognize that there is a distance (i.e. some distance) of at least 0.8mm, in the cavity.

14. **Regarding claim 29**, the elements are provided with edges (8, 9) which bear one against the other in a positively locking fashion in the closed state of the base body and serve to receive at least one of the connection points.

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15. **Regarding claim 30**, the elements are connected to one another by plasma jet welding (see para. [0021]).
16. **Regarding claim 32**, the plastic is embodied as a plastic structure.
17. **Regarding claim 33**, the plastic structure is embodied at least partially or completely as a separate module and can be inserted into the base body.
18. **Regarding claim 34**, the plastic structure is embodied as a plastic reinforcing structure, in particular as internal ribbing, and/or as a plastic guiding structure, in particular as a flow element.
19. **Regarding claim 36**, the plastic has a varying thickness in certain areas. This is inherent, as local variations in thickness will always be present.
20. **Regarding claim 38**, the base body has a varying wall thickness in certain areas. This is inherent, as local variations in thickness will always be present.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. **Claims 31 are 39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mainka in view of Shikata (US20020145309).
23. Mainka discloses substantially the claimed invention, except for coating the base body at least partially with foam having a varying wall thickness.

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24. Shikata discloses coating an inner surface of a base body with foam, for vibration attenuation, noise absorption, and heat insulation (see abstract). See Figs. 4A-4C. See para. [0161].

25. At the time the invention was made, ne of ordinary skill in the art would have found it obvious to coat the base body of Mainka with a foam material, in view of the teachings of Shikata, for the same advantages disclosed by Shikata. Moreover, one of skill in the art will recognize that the thickness will inherently vary, even if by a very small amount.

26. **Claims 35 and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mainka.

27. Mainka discloses substantially the claimed invention, except for the plastic having a thickness between 0.8 and 10mm, nor the base body having a wall thickness of 0.4 mm to 2.0 mm. Mainka does disclose the base body being made of metal (see aluminum shells 5 and 6; see para [0021]).

28. While Mainka does not disclose the claimed dimensions, Mainka specifies that both the base body and the plastic are thin-walled (see para [0021]).

29. At the time the invention was made, one of ordinary skill in the art would have found it obvious to choose the thickness of the plastic and base body as suitable for this particular application, including the claimed thicknesses, if such values provide sufficient structural rigidity. The goal on one of ordinary skill in the art would, clearly, be to utilize materials of the smallest possible thickness while still being sufficiently rigid, in order to minimize the weight of the structural elements.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LIVIUS R. CAZAN whose telephone number is (571)272-8032. The examiner can normally be reached on M-F 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DERRIS H. BANKS can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Livius R. Cazan/ 9/20/2010
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